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EXAMINER

DARNO, PATRICK A

ART UNIT

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2169

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/643,029

Applicant(s)

SMITH, CHRISTOPHER D.

Examiner

PATRICK A. DARNO

Art Unit

2169

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period **will** apply and **will** expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply **will**, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11/26/2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 and 54-61 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 and 54-61 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. Claims 57-61 are new. Claims 1 and 54 have been amended. Claims 18-53 are canceled. Claims 1-17 and 54-61 are pending in this office action.

#### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-14, 16-17, and 54-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 6,980,817 issued to Albert Chow et al. (hereinafter "Chow") in view of U.S. Patent Application Publication Number 2003/0065738 issued Victor Shiang Yang et al. (hereinafter "Yang") and further in view of U.S. Patent Application Publication Number 2004/0087300 issued to John Ervin Lewis (hereinafter "Lewis").

#### **Claim 1:**

Chow discloses a system for triggering a provision event in a service provider using a provisioning request message stored in a computer-readable medium generated by an external system (*Chow: column 2, lines 47-65 and column 13, line 52 - column 14, line 6*), comprising:

a provisioning system operable to electronically receive the provisioning request message from the external system and transmit information in the provisioning request message to trigger the provisioning event, the provisioning system being a separate entity from the external system and the service provider (*Chow: column 2, lines 47-65 and column 13, line 52 - column 14, line 6 and column 10, lines 28-36*);

the provisioning request message including an entity to which the provisioning event pertains, wherein the identifying information includes one or more attributes defined by the external system (*Chow: column 2, lines 47-65 and column 13, line 52 - column 14, line 6 and column 10, lines 28-36*);

the provisioning system in communication with the external system and the service provider, wherein the service provider is operable to communicate with the entity to cause the provisioning event to occur in response to receiving the provisioning request message from the provisioning system (*Chow: column 2, lines 47-65 and column 13, line 52 - column 14, line 6 and column 10, lines 28-36*);

the service provider operable to provide mobile communication service to the entity (*Chow: column 2, lines 47-65 and column 13, line 52 - column 14, line 6 and column 10, lines 28-36*).

Chow fails to explicitly disclose wherein the provisioning request message is an electronic message having a data structure.

However, Yang discloses wherein the provisioning request message is an electronic message having a data structure (*Yang: paragraph [0051]; The trigger message is the provisioning request message.*).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Chow with the teachings of Yang noted above. The skilled artisan would have been motivated to improve the invention of Chow with the teachings of Yang noted above in order to help establish a method of updating services received from a service provider without first requiring a request from a user (*Yang: paragraph [0035]*). This would ensure

the user of having the assurance and stability of knowing that the applications and services being used on his mobile device are always current and up-to-date.

The combination of Yang and Chow fails to expressly disclose a provisioning reply, wherein the provisioning system uses the provisioning reply to return status information or error information relating to the provisioning request message to the external system.

However, Lewis discloses a provisioning reply, wherein the provisioning system uses the provisioning reply to return status information or error information relating to the provisioning request message to the external system (*Lewis: paragraph [0306]*).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the previously mentioned combination with the teachings of Lewis noted above. The skilled artisan would have motivated to improve the previously mentioned combination such that a user could be notified that a specific, attempted operation has not been successful (*Lewis: paragraph [306]*).

**Claim 2:**

The combination of Chow, Yang, and Lewis discloses all the elements of claim 1, as noted above, and Chow further discloses wherein the one or more attributes include a name attribute that identifies the entity (*Chow: column13, lines 59-64; Note that the point-of-sale information includes the subscriber name.*).

**Claim 3:**

The combination of Yang, Chow, and Lewis discloses all the elements of claim 1, as noted above, and Lewis discloses wherein the one or more attributes include a type attribute that identifies an entity type of the entity (*Lewis: paragraph [0121], lines 5-9*).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the previously mentioned combination with the teachings of Lewis noted above for the purpose of including a destination device type inside a provisioning request (*Lewis: paragraph [0121], lines 5-9 and paragraph [0127], lines 1-5; First note that the routing information contains a device type. Then note that the routing information is part of the overall provisioning message to be sent.*). The skilled artisan would have been motivated to improve the previously mentioned combination per the above such that the destination device type would aid in the delivery process of the provisioning request (*Lewis: paragraph [0151], lines 5-8*).

**Claim 4:**

The combination of Chow, Yang, and Lewis discloses all the elements of claim 3, as noted above, and Lewis further discloses wherein the type attribute identifies a model number of the entity (*Lewis: paragraph [0361], lines 1-4; The mobile identification number is the model number.*).

**Claim 5:**

The combination of Chow, Yang, and Lewis discloses all the elements of claim 1, as noted above, and Chow further discloses wherein the service provider is a mobile data service provider (*Chow: column 2, line 47 – column 3, line 3*).

**Claim 6:**

The combination of Chow, Yang, and Lewis discloses all the elements of claim 1, as noted above, and Chow further discloses wherein the provisioning request message further includes provisioning data that identifies a particular entity to which the provisioning event

pertains (*Chow: column 2, lines 47-65 and column 13, line 52 - column 14, line 6; See at least the unique electronic serial identification number (MSID).*).

**Claim 7:**

The combination of Chow, Yang, and Lang discloses all the elements of claim 6, as noted above, and Chow further discloses wherein the particular entity is a mobile communication device (*Chow: column 13, line 52 – column 14, line 6 and column 2, lines 43-46; The mobile station (MS) is the mobile communication device.*).

**Claim 8:**

The combination of Chow, Yang, and Lewis discloses all the elements of claim 6, as noted above, and Chow further discloses wherein the provisioning data includes one or more attributes defined by the external system (*Chow: column 2, lines 47-65 and column 13, line 52 - column 14, line 6; The attributes defined by the external system include subscriber name, address, credit card number, unique mobile station identification number (MSID), optional personal identification number (PIN) and other verification numbers.*).

**Claim 9:**

The combination of Chow, Yang, and Lewis discloses all the elements of claim 8, as noted above, and Chow further discloses wherein the one or more attributes include a name attribute that identifies a type of information included within the provisioning data (*Chow: column 2, lines 47-65 and column 13, line 52 - column 14, line 6; See at least subscriber name.*).

**Claim 10:**

The combination of Chow, Yang, and Lewis discloses all the elements of claim 9, as noted above, and Chow further discloses wherein the type of information included within the

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provisioning data includes a personal identification number (PIN) for the entity (*Chow: column 2, lines 47-65 and column 13, line 52 – column 14, line 6; See at least personal identification number (PIN).*).

**Claim 11:**

The combination of Chow, Yang, and Lewis discloses all the elements of claim 9, as noted above, and Chow further discloses wherein the type of information included within the provisioning data includes a product identifier for the entity (*Chow: column 2, lines 47-65 and column 13, line 52 - column 14, line 6; See at least the unique mobile station identification number (MSID).*).

**Claim 12:**

The combination of Chow, Yang, and Lewis discloses all the elements of claim 9, as noted above, and Chow further discloses wherein the type of information included within the provisioning data includes a billing identifier for the entity (*Chow: column 2, lines 47-65 and column 13, line 52 - column 14, line 6; See at least the credit card number.*).

**Claim 13:**

The combination of Chow, Yang, and Lewis discloses all the elements of claim 9, as noted above, and Chow further discloses wherein the type of information included within the provisioning data includes an international mobile subscriber identity identifier (IMSI) for the entity (*Chow: column 14, lines 29-31*).

**Claim 14:**

The combination of Chow and Yang discloses all the elements of claim 9, as noted above, but the previously mentioned combination does not explicitly disclose wherein the type of information included within the provisioning data includes a mobile subscriber integrated services digital network number (MSISDN) for the entity.



However, Lewis discloses wherein the type of information included within the provisioning data includes a mobile subscriber integrated services digital network number (MSISDN) for the entity (*Lewis: paragraph [0388], lines 1-6 and paragraph [0319]*).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the previously mentioned combination with the teachings of Lewis noted above. The skilled artisan would have been motivated to improve the previously mentioned combination per the above such that the MSISDN could be used to indicate the mobile directory number for a particular device (*Lewis: paragraph [0388], lines 1-6 and paragraph [0319]*).

**Claim 16:**

The combination of Chow and Yang discloses all the elements of claim 1, as noted above, and but the previously mentioned combination does not explicitly disclose wherein the provisioning request message includes additional information identifying one or more additional entities to which the provisioning event pertains, and wherein the additional information includes one or more attributes defined by the external system.

However, Lewis discloses wherein the provisioning request message includes additional information identifying one or more additional entities to which the provisioning event pertains, and wherein the additional information includes one or more attributes defined by the external system (*Lewis: paragraphs [0172] and [0173]; These references disclose sending provisioning requests to multiple or additional users. The multiple users are taken from a distribution list and all the users receive the same messages. Further additional users can be added to any list. Further for each additional user device type, destination address, and all other attributes are included in the message (this is equivalent to the provisioning entity and provisioning data item sections).*).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the previously mentioned combination with the teachings of Lewis noted above. The skilled artisan would have been motivated to improve the previously mentioned combination per the above such that a single message would contain routing information for multiple devices (*Lewis: paragraph [0121], lines 1-5*).

**Claim 17:**

The combination of Chow, Yang, and Lewis discloses all the elements of claim 16, as noted above, and Lewis further discloses wherein a data structure relationship between the provisioning entity section and the one or more additional provisioning entity sections is defined by the external system (*Lewis: paragraphs [0172]-[0173]; The distribution list on the external system creates the data structure relationship between the additional entities.*).

**Claim 54:**

Claim 54 is rejected under the same reasons set forth in the rejection of claims 1.

**Claim 55:**

The combination of Chow, Yang, and Lewis discloses all the elements of claim 1, as noted above, and Yang further discloses wherein the electronic message is an extensible markup language (XML) message (*Yang: paragraph [0051], lines 8-12*).

**Claim 56:**

Claim 56 is rejected under the same reasons set forth in the rejections of claims 1 and 55.

**Claims 57-61:**

The addition of claims 57-61 is noted. However, claims 57-61 are rejected under the same reasons set forth in the rejection of claim 1.

3. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chow in view of Yang in view of Lewis and further in view of U.S. Patent Application Publication Number 2004/0058652 issued to Christopher M. McGregor et al. (hereinafter “McGregor”).

**Claim 15:**

The combination of Chow, Yang, and Lewis discloses all the elements of claim 9, as noted above, but the previously mentioned combination does not explicitly disclose wherein the type of information included within the provisioning data includes an integrated circuit card identifier (ICCID) for the entity. However, McGregor discloses wherein the provisioning data includes an integrated circuit card identifier (ICCID) for the entity (*McGregor: paragraph [0201]*).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the previously mentioned combination with the teachings of McGregor noted above. The skilled artisan would have been motivated to improve the previously mentioned combination per the above such that the ICCID could be used to identify a particular mobile device (*McGregor: paragraph [0201], at least lines 3-7*).

*Response to Arguments*

**Applicant Argues:**

To expedite prosecution, and in accordance with the examiner's recommendations, claim 1 has been amended to recite, "the provisioning request message being an electronic message having a data structure that includes a provisioning reply, wherein the provisioning system uses the provisioning reply to return status information or error information relating to the provisioning request message to the external system, and wherein the data structure further includes information identifying an entity to which the provisioning event pertains, wherein the identifying information includes one or more attributes defined by the external system."

The applicant respectfully submits that the teachings of Chow, Yang, Lewis, and McGregor, alone or in combination, do not teach or disclose the limitations recited in claim 1, as amended.

**Examiner Responds:**

Examiner is not persuaded. The Examiner asserts that Lewis discloses the provisioning request message being an electronic message having a data structure that includes a provisioning reply, wherein the provisioning system uses the provisioning reply to return status information or error information relating to the provisioning request message to the external system [Lewis: paragraph [0306]].

Since it appears that each and every element of the Applicant's claimed invention is either disclosed or suggested by the prior art of record, the claims remain rejected under the reasons set forth in the preceding office action.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

#### ***Contact Information***

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to PATRICK A. DARNOW whose telephone number is (571)272-0788. The examiner can normally be reached on Monday - Friday, 9:00 am - 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mohammad Ali can be reached on (571) 272-4105. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Examiner  
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